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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,027	11/21/2000	Arne D. Thormodsen	10004352-1	2390

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,027

Applicant(s)

THORMODSEN ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: amendment filed 6/8/04 to the application filed on 21/21/00.
2. Claims 1-20 are pending in the case. Claims 1, 7, 13, 18 are independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
5. Claim 14 is directed to "positioning a graphical depiction of an assembly of a picture book from the picture book cutout itself into the digital picture book template, where the identifier lines are shown in the graphical depiction to aid in the assembly of the picture book." The claimed limitation is not consistent with the disclosure of the invention since the specification (page 11, lines 15-21) and the drawing (figure 8, #359) disclose placing the image and/or text in the particular page of the picture book template, not positioning the graphical depiction of an assembly of a picture book into the digital picture book template as claimed.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 18-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 18-20 are directed to a picture book template, which is merely non-functional descriptive material, and thus non-statutory.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

9. Claims 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Warmus (US Pat No. 6,327,599 B1, 12/4/01, filed 6/7/95).

Regarding independent claim 18, Warmus discloses:

- a picture book cutout having a number of pages, the pages defined by a number of identifier lines (figures 6a-b, 7a-b, 8a-b, col 7: the pages are defined by the folded lines in a picture book cutout)
- an instruction region including assembly instructions (col 3, line 35 to col 4, line 3: means for assembling implies that such means includes assembly instructions; col 6, lines 25-30: device interface for assembling the pages to produce finished

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books implies that the device interface includes assembling instructions associated with the book template)

- a graphical depiction of an assembly of the picture book from the picture book cutout, wherein the identifier lines are shown in the graphical depiction to aid in the assembly of the picture book (col 7, lines 5-67 and figures 6a-b, 7a-b, 8a-b: the printed forms in these figures show the graphical depiction of an assembly of a picture book where the dotted lines 102, 119a-b are identifier lines to indicate where the paper sheet should be folded and trimmed to assembly pages of a book version)

Regarding claim 19, which is dependent on claim 18, Warmus discloses that wherein an image is positioned on at least one of the pages (col 8, lines 5-25: specifying the position and content of fixed information on the pages).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-17, 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al. (US Pat No. 6,327,599 B1, 12/4/01, filed 6/7/95).

Regarding independent claim 13, Warmus discloses:

- obtaining a number of content items in a computer system to be depicted in a picture book cutout in the digital picture book template (col 3, lines 12-22: template data used in the book template)
- defining a number of pages of the picture book cutout in the computer system with a number of identifier lines (figures 6a-b, 7a-b, 8a-b and col 7 : number of pages is defined by folded lines 102, 119a, 119b)
- associating at least one of the content items with at least one of the pages (figures 6a-b, 7a-b, 8a-b, 9 and col 9, lines 15-56: insert text or image in the pages)
- associating a set of assembly instructions with the digital picture book template (col 6, lines 25-30: device interface for assembling the pages to produce finished books suggests that the device interface include assembling instructions)

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associated with the book template; col 3, line 35 to col 4, line 3: assembling a book using the book template implies that assembly instructions are associated with the book template to perform said assembling)

Warmus does not disclose that the obtaining step and the defining step occur in a server. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Warmus to include the occurrence of step obtaining and step defining in a server for the following reason. Warmus discloses a system for producing books using book templates. Therefore, the system is considered as a server that provides (or serves) data to be inserted in the book templates to produce books based on different requests for different book versions. The step of obtaining a number of content items and the step of defining a number of pages, accordingly, should be happened in said server system.

Regarding claim 14, which is dependent on claim 13, Warmus discloses a graphical depiction of an assembly of a picture book from a picture book cutout where the identifier lines are shown in the graphical depiction to aid the assembly of the picture book (figures 6a-b, 7a-b, 8a-b: the printed forms in these figures show the graphical depiction of an assembly of a picture book where the dotted lines 102, 119a-b are identifier lines to indicate where the paper sheet should be folded to assembly pages of a book version (col 7, lines 5-67)).

Warmus also disclose that one or more template files are developed by a publisher specifying the content (including appearance) of fixed information and the positioning of

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all information in the different books or book versions where *the content of variable information to be placed in variable information area, for example the area 110, 112 on the pages P1, P4* of the book versions respectively of figures 6a-b (figure 5, col 8, lines 5-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Warmus to include positioning the graphical depiction of the picture book into a book template for the following reason. Warmus discloses the graphical depiction of a book version via printed sheets with dotted lines indicating where to fold and trim the paper sheets to assembly a book and the book template thus motivating to include positioning said depiction with text and image content into the book template in order to produce a book version as desired.

Regarding claim 15, which is dependent on claim 13, Warmus discloses identifying a graphical position of the at least one content item on the at least one page (col 8, lines 16-25; col 9, line 62 to col 10, line 14: specifying the position and content of fixed information on the pages).

Regarding claim 16, which is dependent on claim 15, Warmus discloses identifying a graphical position of the at least one content item on the at least one page further comprises the step of rotating the at least one content item (col 13, lines 26-35: books of different versions have different fixed and variable that vary in terms of content or appearance where appearance means style, location, *rotation*, position, etc. The fact

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that rotation is one of the factors that affects the appearance of the books of different versions suggests rotating the at least one content item in the book producing process).

Regarding claim 17, which is dependent on claim 15, Warmus discloses resizing the at least one content item to fit on the at least one page (figure 10d, col 13, line 64 to col 14, line 8: scaling image to fit into a page).

Claims 1-6 are for a system for creating a digital picture template of method claims 13-17, and are rejected under the same rationale.

Claims 7-12 include the same limitations as in claims 1-6, and are rejected under the same rationale.

Regarding claim 20, which is dependent on claim 18, Warmus does not disclose a correspondence between an identifier line in the picture book cutout and an identifier line in the graphical depiction is indicated with a predefined color.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Warmus to include said correspondence since it was well known in document processing that text, line or graphic in a document can be set in a desired color for differentiating purpose. The identifier line in the picture book cutout and the identifier line in the graphical depiction, accordingly, must be set in the same desired color for easily identifying.

Response to Arguments

13. Applicants' arguments filed on 6/8/04 have been considered but are not persuasive.

Regarding independent claim 13, Applicants argue that Warmus does not disclose associating a set of assembly instructions with the digital picture book template since "the finishing apparatuses described by Warmus perform predefined finishing operations and do not respond to assembly instruction included in the digital picture book template as claimed", and thus, "it is unlikely that finishing devices require assembly instructions as they are configured to performed predefined finishing operations based upon operator selection and configuration" (Remarks, page 8).

Examiner respectfully disagrees.

The finishing apparatus in Warmus includes various auxiliary production devices and device interface for assembling the pages to produce finished books (col 6, lines 25-30). Since a finished book is produced by filling data such as text and image into a page of a book template, and by binding the filled pages together, instructions for such a assembling have to be associated with the book template.

Regarding claim 14, which is dependent on claim 13, Applicants argue that Warmus does not disclose positioning a graphical depiction of an assembly of a picture book from a picture book cutout into a digital picture book template, where the identifier lines are shown in the graphical depiction to aid in the assembly of the picture book (Remarks, page 9).

Examiner respectfully disagrees.

Warmus discloses a graphical depiction of an assembly of a picture book from a picture book cutout where the identifier lines are shown in the graphical depiction to aid the assembly of the picture book (figures 6a-b, 7a-b, 8a-b: the printed forms in these figures show the graphical depiction of an assembly of a picture book where the dotted lines 102, 119a-b are identifier lines to indicate where the paper sheet should be folded to assembly pages of a book version (col 7, lines 5-67)).

Warmus also disclose that one or more template files are developed by a publisher specifying the content (including appearance) of fixed information and the positioning of all information in the different books or book versions where the content of variable information to be placed in variable information area, for example the area 110, 112 on the pages P1, P4 of the book versions respectively of figures 6a-b (figure 5, col 8, lines 5-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Warmus to include positioning the graphical depiction of the picture book into a book template for the following reason. Warmus discloses the graphical depiction of a book version via printed sheets with dotted lines indicating where to fold and trim the paper sheets to assembly a book thus motivating to include positioning said depiction with text and image content into the book template in order to produce a book version as desired.

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Regarding claim 20, Applicants argue that Warmus does not disclose a graphical depiction, thus does not further suggest the use of color coding in the identifier lines within the graphical depiction that correspond to indicator lines in the template (Remarks, page 11).

Examiner respectfully disagrees. Since Warmus does disclose the claimed graphical depiction via the printed sheets showing how to assemble a book, it is suggested to use the color coding in the identifier lines within the graphical depiction.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Guttman et al. (US Pat No. 6,366,918 B1, 4/2/02, filed 3/21/00, priority 2/28/97).

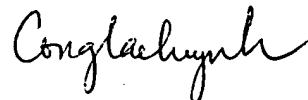
Hidding et al. (US Pat No. 6,338,076 B1, 1/8/02, filed 12/31/97).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Examiner
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